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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/538,792
Filing Date: March 30, 2000
Appellant(s): DI CARLO ET AL.

Werner H. Stermer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07/20/05 appealing from the Office action mailed 07/23/04.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Appellant's brief presents arguments relating to whether the term "new" raises new issues. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,333,973

Smith et al.

12-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 line 2 recites "a message", line 4 recites "a new message", line 10 recites "the message", line 11 recites "a new message", and line 12 recites "the new message". It is unclear and indefinite if these messages are referring to the same message or are different messages. The specification on page 9 discloses several different types of messages (*e.g. text messages, voice messages, SMS messages, and email messages*), therefore the lack of antecedent basis, specifically for "the message" in line 10 and "a new message" in line 11 makes the claim unclear as this could be read as a different new message. Examiner interprets all of the recited messages as one same new message and the notification in line 8 as a notification message transmitted before the new message.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al., Patent #6,333,973.

Appellant did not argue the merits of the art rejection, therefore the Final Rejection is not repeated herein and is incorporated by reference.

(10) Response to Argument

I. Appellant argues that the Smith patent, #6,333,973, filed 04/23/1997 cited above is not available as prior art against the present claims because of submittal of a 37 CFR 1.131 declaration dated 04/24/1997. Examiner respectfully disagrees as the declaration has been considered but is ineffective to overcome the Smith patent.

Appellant has failed to prove conception or reduction to practice of the invention Prior to the effective date of the Smith reference. The evidence submitted by appellant which is written as a 'patent proposal' is dated 04/24/1997, a day After the effective date of the Smith reference. Furthermore, merely alleging that conception and reduction to practice occurred before the Smith reference is not sufficient. At a minimum, MPEP requires there must be evidence that proves at least conception of the claimed invention Prior to the Smith patent coupled with due diligence from prior to the reference date.

As outlined in the MPEP section 715.07 [R-2], 37 CFR 1.131(b) states:

III. THREE WAYS TO SHOW PRIOR INVENTION

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to

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practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual)reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

*A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, **UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT**, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).*

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. See MPEP §

2138.04 through § 2138.06 for a detailed discussion of the concepts of conception, reasonable diligence, and reduction to practice.

In view of the patent laws above, the evidence submitted After the effective date of the Smith patent and a mere statement by Appellant and Inventors that conception and reduction to practice occurred before 04/23/1997 is insufficient.

It is also noted that appellant contradicts his statements on page 20-21 of the brief. Stating on one hand, that both inventors have sworn, in the declaration of November 2002, that *"the present invention was reduced to practice prior to April 23, 1997"*, the filing date of the Smith patent and on the other, appellant states at the top of page 21, that *"diligence is shown by filing of a patent application(German) on the disclosed invention only about five months after the Invention Disclosure was signed...."* Here, Appellant admits diligence is shown After the proposed invention disclosure, dated April 24, 1997, which allegedly was already reduced to practice by the inventors. Therefore one would assume the invention disclosure, if already reduced to practice, would incorporate language or evidence of a system that was operational and running, rather the invention disclosure incorporates a proposal of how the system should and may operate(see the term "may" used throughout the proposal pages 3-4).

It is also noted that appellant has not complied with the requirements of 35 U.S.C. 371 to claim priority over the German application filed 09/30/1997 to achieve at least an effective priority date of 09/30/1997 since a certified copy of the German application has not been received by the Patent Office nor a certified translation thereof which was requested in examiner's first office action.

In response to appellant's argument of whether the Smith patent, that was cited in the first non-final action, can be revived and cited again in later actions if it is sworn behind by a 37 CFR 1.131 declaration. In response, It is noted that examiner did not agree nor approve of the 1.131 declaration for it to be sworn behind the Smith patent. The absence of acknowledgement of the affidavit in the corresponding office actions is not proof that the 1.131 declaration was sufficient to overcome the Smith patent. Rather, the 1.131 declaration was overlooked because there was an amendment to the claims submitted by the appellant 1.5 months prior to submitting of the 1.131 declaration in which the examiner had already found and used another reference, Picard, which was applied because of amendments to the claims and not because of the 1.131 declaration.

In summary, because the claims were amended and the examiner never stated nor agreed that the 1.131 affidavit was sufficient to overcome Smith, the examiner is justified in using an earlier applied reference(i.e. Smith patent) in a later office action.

II. This issue of whether or not the addition of the word "new" into claim 1 raises new issues relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

III. In response to whether or not claim 1 is indefinite under 35 USC 112, second paragraph. Examiner notes the 112 final rejection copied below.

Claim 1 line 2 recites "a message", line 4 recites "a new message", line 10 recites

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"the message", line 11 recites "a new message", and line 12 recites "the new message".

It is unclear and indefinite if these messages are referring to the same message or are different messages. The specification on page 9 discloses several different types of messages (*e.g. text messages, voice messages, SMS messages, and email messages*), therefore the lack of antecedent basis, specifically for "the message" in line 10 and "a new message" in line 11 makes the claim unclear as this could be read as a different new message. Examiner interprets all of the recited messages as one same new message and the notification in line 8 as a notification message transmitted before the new message.

Since the primary focus of the invention is notification messages and notification of messages, the antecedent basis' of the "message(s)" are critical to the interpretation of the metes and bounds of the claims. It is merely not known if the claim is limited to only one new message or if it is broad enough to claim another new message. In view of this, the 112 2nd paragraph rejection of claim 1 should be maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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September 22, 2005